



UNITED STATES PATENT and TRADEMARK OFFICE

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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10-5-07

In re application of :
KUKULKA et al. : DECISION ON
Serial No. 10/614,310 : PETITION
Filed: July 7, 2003 :
For: SOLAR CELL STRUCTURE WITH SOLAR :
CELLS HAVING REVERSE-BIAS PROTECTION:
USING AN IMPLANTED CURRENT SHUNT :

This is a decision on the PETITION under 37 CFR 1.144 filed August 29, 2007 to withdraw the restriction requirement mailed November 14, 2006 and made final in the office action mailed June 5, 2007.

On November 14, 2006, a two-way restriction requirement was made by the examiner. The groups of claims as set forth in the requirement were directed to an article and a method. Applicants traversed the restriction requirement in a response filed March 13, 2007 by stating that the reasons supplied by the examiner to show distinctness of the groups was improper. The examiner prepared an office action based on the elected group and made the restriction requirement final. This office action was mailed June 5, 2007.

On August 29, 2007, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that (1) the product can be made by a materially different process and (2) the separate groups are "independent and distinct".

DECISION

Section 803 of the MPEP states:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

In the restriction requirement mailed on November 14, 2006, the examiner required restriction between I. an article and, II. a method. It was argued that inventions I and II are distinct because the article as claimed can be made by materially different methods such as electroplating.

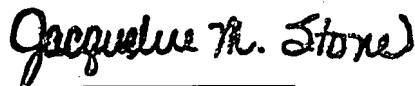
In the response to the restriction requirement, Applicants argued that the examples cited by the examiner to show distinctness fail to meet the burden required for such a showing. It was argued specifically that the instant method claims clearly encompass an embodiment wherein the depositing can be done by electroplating

In response to Applicant's arguments, the examiner in the office action mailed June 5, 2007, maintained the restriction requirement and stated "This is not found persuasive because there is nothing in claim 8 mentioning about electroplating. The term "depositing" can be CVD (Chemical Vapor Deposition) or PVD (Physical Vapor Deposition), therefore it would be a serious burden on the Examiner to search for all the methods involving "depositing" ".

Applicants had set forth clear and persuasive arguments showing why the requirement was in fact in error. The fact that the claims would encompass the examples provided by the examiner demonstrate that the claims are not in fact distinct for the reasons given by the examiner. The examiner's argument that claim 8 does not mention electroplating is not persuasive because the claim generically recites depositing. Electroplating is a species of the generic depositing limitation. Because the examiner has not shown that the groups of claims are independent and distinct, the restriction requirement is not proper.

Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**.

The application is being forwarded to the examiner to prepare a new non-final office action which includes examination and action on the merits of the claims previously withdrawn from consideration due to the restriction requirement.



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